

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Re PATENT APPLICATION of
Inventor(s): Stice et al.



PATENT
APPLICATION

Appln. No. 09/394,902

Group Art Unit: 1632

series code ↑ ↑ serial no.

Filed: December 20, 2000

Examiner: T. Ton

#17
BP
2-5-03

Title: Cloning Pigs Using Donor Cells or Nuclei From Differentiated Cells (Somatic or Germ Cells) and Production of Pluripotent Porcine Cells by Nuclear Transfer

TERMINAL DISCLAIMER

(By Attorney)

Re Double-Patenting Rejection

RECEIVED

JAN 17 2003

TECH CENTER 1600/2900

Hon. Commissioner of Patents and Trademarks
Washington, D.C. 20231

Sir:

The undersigned petitioner, an attorney of record, is hereby acting for the undernamed entity which is the 100% owner of all rights, title and interests in and to the subject application:

1. ☐ by virtue of being the inventor(s) and having not assigned this application
2. ☐ as shown by the Assignment recorded _____ on Reel _____ at Frame _____
(date)
3. ☒ as shown by the attached copy of the Assignment filed for recordal on April 6, 2000
(date)
4. ☐ and, if the assignor in that Assignment is not the original owner (inventor(s)), the chain of title from the original owner to that Assignment as recorded on Reel _____ at Frame _____
Reel _____ at Frame _____ Reel _____ at Frame _____

and hereby disclaims (except as provided below) the terminal part of the statutory term of any patent granted on the subject application, which would extend beyond the expiration date of the full statutory term defined in 35 U.S.C. 154 to 156 and 173, as presently shortened (if at all) by any terminal disclaimer of:

5. ☐ any patent granted in regard to U.S. Application No. 0 / _____ filed _____ *
6. ☒ the earlier granted United States Patent No. 6,235,969 and 5,945,577 _____ *

to which said entity also has legal title. Petitioner hereby reserves the right to extend the term of the patent, which issues on this application, for regulatory delay or otherwise as the law allows. Petitioner hereby agrees that any patent so granted on the subject application shall be enforceable only for and during such period that it and the patent in the above line numbered 5 or 6 are commonly owned. This agreement runs with any patent granted on the subject application and is binding upon the grantee, its successors or assigns.

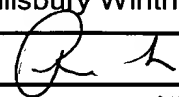
01/16/2003 CCHAU1 00000059 033975 09394902

02 FC:1814 110.00 CH

In making the above disclaimer, petitioner does not disclaim the terminal part of any patent granted on the instant application that would extend to the expiration date of the full statutory term as defined in 35 U.S.C. 154 to 156 and 173 of the patent in line numbered 5 or 6 above, as presently shortened by any terminal disclaimer, of the above-listed patent in the event that it later: expires for failure to pay a maintenance fee, is held unenforceable, is found invalid by a court of competent jurisdiction, is statutorily disclaimed in whole or terminally disclaimed under 37 CFR 1.321, has all claims canceled by a reexamination certificate, is reissued, or is otherwise terminated prior to the expiration of its full statutory term as presently shortened by any terminal disclaimer.

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

Entity: Pillsbury Winthrop LLC

Atty. Sig. 

Attorney of Record:

Name: Robin L. Teskin

Reg. No.: 35,030

Date: January 15, 2003

* Attorney and client: Please note on that other file and also this appln. file not to assign either separately in view of this disclaimer.

☒ Terminal disclaimer fee under 37 CFR 1.20(d) is enclosed.



CRK
UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office
ASSISTANT SECRETARY AND COMMISSIONER
OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

JUNE 27, 2000

PTAS

BURNS, DOANE, SWECKER & MATHIS, L.L.P.
ROBIN L. TESKIN
P.O. BOX 1404
ALEXANDRIA, VA 22313-1404



101340055A

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UNITED STATES PATENT AND TRADEMARK OFFICE
NOTICE OF RECORDATION OF ASSIGNMENT DOCUMENT

TECH CENTER 1600/29

THE ENCLOSED DOCUMENT HAS BEEN RECORDED BY THE ASSIGNMENT DIVISION OF THE U.S. PATENT AND TRADEMARK OFFICE. A COMPLETE MICROFILM COPY IS AVAILABLE AT THE ASSIGNMENT SEARCH ROOM ON THE REEL AND FRAME NUMBER REFERENCED BELOW.

PLEASE REVIEW ALL INFORMATION CONTAINED ON THIS NOTICE. THE INFORMATION CONTAINED ON THIS RECORDATION NOTICE REFLECTS THE DATA PRESENT IN THE PATENT AND TRADEMARK ASSIGNMENT SYSTEM. IF YOU SHOULD FIND ANY ERRORS OR HAVE QUESTIONS CONCERNING THIS NOTICE, YOU MAY CONTACT THE EMPLOYEE WHOSE NAME APPEARS ON THIS NOTICE AT 703-308-9723. PLEASE SEND REQUEST FOR CORRECTION TO: U.S. PATENT AND TRADEMARK OFFICE, ASSIGNMENT DIVISION, BOX ASSIGNMENTS, CG-4, 1213 JEFFERSON DAVIS HWY, SUITE 320, WASHINGTON, D.C. 20231.

RECORDATION DATE: 04/06/2000

REEL/FRAME: 010732/0651
NUMBER OF PAGES: 5

BRIEF: ASSIGNMENT OF ASSIGNOR'S INTEREST (SEE DOCUMENT FOR DETAILS).

ASSIGNOR:
CIBELLI, JOSE

DOC DATE: 09/20/1999

ASSIGNOR:
ROBL, JAMES M.

DOC DATE: 10/05/1999

ASSIGNEE:
UNIVERSITY OF MASSACHUSETTS, A
PUBLIC INSTITUTION OF HIGHER
EDUCATION OF THE COMMONWEALTH OF
MASSACHUSETTS, AS REPRESENTED BY
ITS AMHERST CAMPUS
OFFICE OF VICE CHANCELLOR FOR
RESEARCH AT AMHERST
AMHERST, MASSACHUSETTS 01002

000270-026
Advanced Cell Technology
RLT

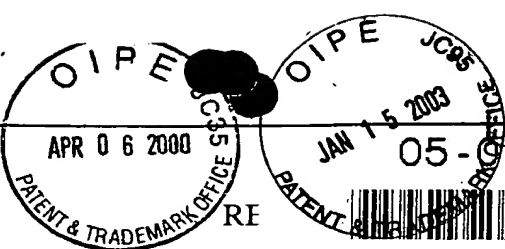
BURNS, DOANE, SWECKER & MATHIS, L.L.P. RECEIVED WF. JUL 3 2000 DOCKETED 7.3.00

SERIAL NUMBER: 09394902
PATENT NUMBER:

FILING DATE: 09/13/1999
ISSUE DATE:

010732/0651 PAGE 2

MARY BENTON, EXAMINER
ASSIGNMENT DIVISION
OFFICE OF PUBLIC RECORDS



05-01-2000

U.S. DEPARTMENT OF COMMERCE
Patent and Trademark Office

ET

101340055

Attorney's Docket No. 000270-026

To the Honorable Commissioner of Patents and Trademarks. Please record the attached original documents or copy thereof.

1. Name of conveying party(ies):

Jose CIBELLI and James M. ROBL

Additional name(s) of conveying party(ies) attached? ☐ Yes ☒ No

3. Nature of conveyance:

☒ Assignment ☐ Merger
☐ Security Agreement ☐ Change of Name

Other: _____

Execution Date: 9/20/99 & 10/5/99, respectively

2. Name and address of receiving party(ies):

Name: UNIVERSITY OF MASSACHUSETTS, A
PUBLIC INSTITUTION OF HIGHER EDUCATION
OF THE COMMONWEALTH OF
MASSACHUSETTS, AS REPRESENTED BY ITS
AMHERST CAMPUS

Address: Office of Vice Chancellor for Research
at Amherst,
Amherst, Massachusetts 01002

Additional name(s) & address(es) attached? ☐ Yes ☒ No

4. Application number(s) or patent number(s):

If this document is being filed together with a new application, the execution date of the application is: _____

A. Patent Application No.(s)

09/394,902

B. Patent No.(s)

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JAN 17 2003

Additional numbers attached? ☐ Yes ☒ No

TECH CENTER 1600/2000

5. Name and address of party to whom correspondence concerning application should be mailed:

Name: Robin L. Teskin

Address: BURNS, DOANE, SWECKER & MATHIS, L.L.P.

P.O. Box 1404

Alexandria, Virginia 22313-1404

6. Total number of applications and patents involved: 1

7. Total fee (37 CFR § 3.41): \$ 40.00

☒ Enclosed

☐ Authorized to be charged to deposit account, if necessary

8. Deposit account number:

02.4800

04/20/2000 JSHABAZZ 00000144 09394902

01-FC:581

(40.00)

DO NOT USE THIS SPACE

9. Statement and signature.

To the best of my knowledge and belief, the foregoing information is true and correct and any attached copy is a true copy of the original document.

Robin L. Teskin
Name of Person Signing

Robin L. Teskin
Signature

April 6, 2000
Date

Total number of pages including cover sheet, attachments, and document: 5

Mail documents to be recorded with required cover sheet information to:

Commissioner of Patents and Trademarks
Box Assignments
Washington, D.C. 20231

ASSIGNMENT (JOINT)

THIS ASSIGNMENT, by STEVEN L. STICE; JOSE CIBELLI; JAMES M. ROBL; AND PAUL GOLUEKE, residing at 468 AMHERST ROAD, BELCHERTOWN, MA 01007; 166 VILLAGE PARK, AMHERST, MA 01002; 196 OLD ENFIELD, BELCHERTOWN, MA 01007; AND 8 DIANE DRIVE #3, BELCHERTOWN, MA 01007 (hereinafter referred to as "the Assignors"), respectively, witnesseth:

WHEREAS, the Assignors have invented certain new and useful improvements in CLONING PIGS USING DONOR CELLS OR NUCLEI FROM DIFFERENTIATED CELLS (SOMATIC OR GERM CELLS) AND PRODUCTION OF PLURIPOTENT PORCINE CELLS BY NUCLEAR TRANSFER,
☐ which is a provisional application to be filed herewith; ☐ which is a non-provisional application having an oath or declaration executed on even date herewith prior to filing of application;
☒ bearing Application No. 09/, and filed on SEPTEMBER 13, 1999; and

WHEREAS, UNIVERSITY OF MASSACHUSETTS, A PUBLIC INSTITUTION OF HIGHER EDUCATION OF THE COMMONWEALTH OF MASSACHUSETTS, AS REPRESENTED BY ITS AMHERST CAMPUS, and having its principal place of business at OFFICE OF VICE CHANCELLOR FOR RESEARCH AT AMHERST, AMHERST, MASSACHUSETTS 01002 (hereinafter referred to as "the Assignee"), is desirous of acquiring the entire right, title, and interest in and to said inventions, the right to file applications on said inventions and the entire right, title and interest in and to any applications, including provisional applications for Letters Patent of the United States or other countries claiming priority to said application, and in and to any Letters Patent or Patents, United States or foreign, to be obtained therefor and thereon.

NOW, THEREFORE, in consideration of One Dollar (\$1.00) and other good and sufficient consideration, the receipt of which is hereby acknowledged, the Assignors have sold, assigned, transferred, and set over, and by these presents do sell, assign, transfer, and set over, unto the Assignee, its successors, legal representatives, and assigns the entire right, title, and interest in and to the above-mentioned inventions, the right to file applications on said inventions and the entire right, title and interest in and to any applications for Letters Patent of the United States or other countries claiming priority to said application, and any and all Letters Patent or Patents of the United States of America and all foreign countries that may be granted therefor and thereon, and in and to any and all applications claiming priority to said applications, divisions, continuations, and continuations-in-part of said applications, and reissues and extensions of said Letters Patent or Patents, and all rights under the International Convention for the Protection of Industrial Property, the same to be held and enjoyed by the Assignee, for its own use and behalf and the use and behalf of its successors, legal representatives, and assigns, to the full end of the term or terms for which Letters Patent or Patents may be granted as fully and entirely as the same would have been held and enjoyed by the Assignors had this sale and assignment not been made;

AND for the same consideration, the Assignors hereby covenant and agree to and with the Assignee, its successors, legal representatives, and assigns, that, at the time of execution and delivery of these presents, the Assignors are the sole and lawful owners of the entire right, title, and interest in and to the inventions set forth in said applications and said applications, including provisional applications, above-mentioned, and that the same are unencumbered, and that the

Assignors have good and full right and lawful authority to sell and convey the same in the manner herein set forth;

AND for the same consideration, the Assignors hereby covenant and agree to and with the Assignee, its successors, legal representatives, and assigns that the Assignors will, whenever counsel of the Assignee, or the counsel of its successors, legal representatives, and assigns, shall advise that any proceeding in connection with said inventions or said applications for Letters Patent or Patents, or any proceeding in connection with Letters Patent or Patents for said inventions in any country, including interference proceedings, is lawful and desirable, or that any application claiming priority to said application, division, continuation, or continuation-in-part of any applications for Letters Patent or Patents, or any reissue or extension of any Letters Patent or Patents to be obtained thereon, is lawful and desirable, sign all papers and documents, take all lawful oaths, and do all acts necessary or required to be done for the procurement, maintenance, enforcement, and defense of Letters Patent or Patents for said inventions, without charge to the Assignee, its successors, legal representatives, and assigns, but at the cost and expense of the Assignee, its successors, legal representatives, and assigns;

AND the Assignors hereby request the Commissioner of Patents to issue any and all said Letters Patent of the United States to the Assignee as the Assignee of said inventions, the Letters Patent to be issued for the sole use and behalf of the Assignee, its successors, legal representatives, and assigns.

Date _____ Signature of Assignor _____

Steven L. STICE

Date 9/20/98 Signature of Assignor _____

Jose CIBELLI

Date _____ Signature of Assignor _____

James M. ROBL

Date _____ Signature of Assignor _____

Paul GOLUEKE

SUBJECT: DECISION ON TERMINAL DISCLAIMERS INFORMAL FORM

DATE: 2-3-03

APPL. S.N.: 091 394 902

TO EXAMINER: T-Ten

ART UNIT: 1632

ROOM

MAILROOM DATE 1-15-03

AFTER FINAL YES ☐ NO ☒ NUMBER OF T.D(S). FILED 1

INSTRUCTIONS: I have reviewed the submitted T.D. with the results as set forth below. If you agree, please use the appropriate form paragraphs identified by this informal memo in your next office action to notify applicant about the T.D. If you disagree with my analysis or have questions at all about the acceptability of the T.D., please see me or our Special Program Examiner. THIS MEMO IS AN INFORMAL, INTERNAL MEMO ONLY. IT MUST NOT BE MAILED TO APPLICANT, NOR SHOULD A COPY BE LEFT IN FILE.

WILLIAM N. PHILLIPS
PATENT ANALYST

☒ The T.D. is PROPER and has been recorded. (See 14.23).

☐ The T.D. is NOT PROPER and has not been accepted for the reason(s) checked below. (See 14.24).

☐ The recording fee of \$ _____ has not been submitted nor is there any pre authorization in the application file to charge to a deposit account. (See 14.26.07)

☐ Application Examiner has not processed T.D. fee. (See fee authorization).

☐ The T.D. does not satisfy Rule 321(b)(3) in that the person who has signed the T.D. has not stated his/her interest (and/or the extent of the interest of the business entity represented by the signature) in the application/patent. (See 14.26 and 14.26.01).

☐ The T.D. lacks the enforceable only during the common ownership clause needed to overcome a double patenting rejection, Rule 321(c). (See 14.27, 14.27.01).

☐ It is directed to a particular claims(s), which is not acceptable since "the disclaimer must be of a terminal portion of the term of the entire patent to be granted". MPEP 1490. (See 14.26, 14.26.02).

☐ The person who signed the terminal disclaimer:

☐ has failed to state his/her capacity to sign for the business entity, (See 14.28).

☐ is not recognized as an officer of the assignee, (See 14.29 and possibly 14.29.01).

☐ No documentary evidence of a chain of title from the original inventor(s) to assignee has been submitted, nor is the reel and frame specified as to where such evidence is recorded in the office. 37 CFR 3.73(b). (See 1140 O.G. 72). **NOTE:** This documentary evidence or the specifying of the reel and frame may be found in the T.D. or in a separate paper submitted by applicant. (See 14.30).

☐ No "statement" specifying that the evidentiary documents have been reviewed and that, to the best of the assignee's knowledge and belief the title is in the assignee seeking to take action. 37 CFR 3.73(b). (See 1140 O.G. 72) (See 14.31).

☐ The T.D. is not signed. (See 14.26, 14.26.3). or 14.26.03 if TD is not signed by all the owners.

☐ Attorney not of record in oath/decl. or a separate paper filed appointing a new or associate attorney. (See 14.29.01).

☐ The serial number of the application (or the number of the patent) which forms the basis for the double patenting is missing or incorrect. (See 14.32).

☐ The serial number of this application (or the number of the patent in reexam or reissue case(s) being disclaimed is missing or incorrect. (See 14.26, 14.26.04 or 14.26.05).

☐ The period disclaimed is incorrect or not specified. (See 14.27, 14.27.2 or 14.27.3)(For Samples 14.27.04 and 14.27.05)

☐ Other: _____

☐ Suggestion to request refund of \$ _____. (See 14.35, 14.36).

☐ **EXAMINER NOTE: IF APPLICATION IS IN CONDITION FOR ALLOWANCE ANY OF THE ABOVE INFORMALTIES MAY BE FAXED IN TO THE GROUP**

FOR SAMPLE TERMINAL DISCLAIMERS AND CERTIFICATES:

☐ Sample of a TD over a pending application and assignee Certificate (See 14.37).

☐ Sample of a TD over a prior patent and assignee Certificate (See 14.38).

☐ Sample Assignee Certificate under 37 CFR 3.73 (b) (See 14.39)

Inventor(s): Stice et al.

Appl. No.: 09/

394,902

Series Code ↑

Serial No. ↑

Filed: December 20, 2000

Hon. Commissioner of Patents
Washington, D.C. 20231

Sir:

REPLY/AMENDMENT/LETTER

Group Art Unit 1632

Examiner: T. Ton

Atty. Dkt. P 0275963

M#

Client Ref

Appl. Title: Cloning Pigs Using Donor Cells or
Nuclei From Differentiated Cells
(Somatic or Germ Cells) and Production
of Pluripotent Porcine Cells by Nuclear
Transfer

Date: January 15, 2003

This is a reply/amendment/letter in the above-identified application and includes the herewith attachment of same date and subject which is incorporated hereinto by reference and the signature below is treated as the signature to the attachment in absence of a signature thereto.

FEE REQUIREMENTS FOR CLAIMS AS AMENDED

1. Small Entity claim A. <input type="checkbox"/> NOT made B. <input type="checkbox"/> Withdrawn C. <input type="checkbox"/> made herewith D. <input checked="" type="checkbox"/> made previously		For B & C See Required Separate Paper (Pat-256)		Claims remaining after amendment	Highest number previously paid for	Present Extra	Large/Small Entity	Additional Fee	Fee Code Lg/Sm
2. Total Effective Claims				**minus	0	0	x \$18/\$9 =	+ \$0	103/203
3. Independent Claims				***minus	0	0	x \$84/\$42 =	+ \$0	102/202
4. If amendment enters proper multiple dependent claim(s) into this application for first time (leave blank if this is a reissue application)..... add							+ \$280/\$140 =	+ \$0	104/204
5. Original due Date: December 13, 2002				<input type="checkbox"/> NONE					
6. Petition is hereby made to extend the original due date to cover the date this response is filed for which the requisite fee is attached				(1 mo) (2 mos) (3 mos) (4 mos) (5 mos)	\$110/\$55 = \$410/\$205 = \$930/\$465 = \$1,450/\$725 = \$1,970/\$985 =	+ \$410			115/215 116/216 117/217 118/218 128/228
7. Enter any previous extension fee paid since above original due date and subtract						- \$0			
8.						Extension Fee	+ \$410		
9. If Terminal Disclaimer attached, add Rule 20(d) official fee						+ \$110/\$55	+ \$110		148/248
10. If IDS attached requires Official Fee under Rule 97 (c),						+ \$180	+ \$0		126
or if Rule 97(d) Request						+ \$180			126
11. After-Final Request Fee per rules 129(a) and 17(r)						+ \$750/370	+ \$0		146/246
12. No. of additional inventions for examination per Rule 129(b).....						x \$750/375 ea	+ \$0		149/249
13. Request for Continued Examination (RCE)						+ \$750/375	+ \$0		1179/1279
14. Petition fee for							+ \$0		
15.						TOTAL FEE =	\$520		
16. *If the entry in this space is less than entry in next space, the "Present Extra" result is "0".									
17. **If the "Highest number previously paid for" in this space is less than 20, write "20" in this space.									
18. ***If the "Highest number previously paid for" in this space is less than 3, write "3" in this space.									
						PLEASE CHARGE OUR DEP. ACCT			

01/16/2003 CCHAU1. 00000059 033975 09394902

Our Deposit Account No. 03-3975)

(Our Order No. 015837 0275963

C#

M#

01 FC-1252 410.00 CH

CHARGE STATEMENT: The Commissioner is hereby authorized to charge any fee specifically authorized hereafter, or any missing or insufficient fee(s) filed, or asserted to be filed, or which should have been filed herewith or concerning any paper filed hereafter, and which may be required under Rules 16-18 (missing or insufficiencies only) now or hereafter relative to this application and the resulting Official Document under Rule 20, or credit any overpayment, to our Accounting/Order Nos. shown above, for which purpose a duplicate copy of this sheet is attached.

This CHARGE STATEMENT does not authorize charge of the issue fee until/unless an issue fee transmittal sheet is filed.

Query: Is appeal deadline now? If so, file Notice of Appeals separately.

Pillsbury Winthrop LLP
Intellectual Property Group

By Atty: Robin L. Teskin

Reg. No. 35,030

P.O. Box 10500
McLean, VA 22102
Tel: (703) 905-2000

Sig:

Fax: (703) 905-2500
Tel: (703) 905-2200

Atty/Sec: RLT/af

NOTE: File this cover sheet in duplicate with PTO receipt (PAT-103A) and attachments